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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,055	09/28/2000	Vijay K. Gajjala	MSFT-0180/138333.1	7632
7590	07/30/2004		EXAMINER	
Steven H Meyer Woodcock Washburn Kurtz Mackiewicz & Norris LLP One Liberty Place 46th Floor Philadelphia, PA 19103			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 07/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/671,055	GAJALA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Reagan	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 22 April 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-3,5-15,23-25,27-37,45-47 and 49-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

**Status of Claims**

1. This action is in response to the Request for Continued Examination filed on 22 April 2004.
2. Claims 4, 16-22, 26, 38-44, 48, and 60-66 have been cancelled.
3. Claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 have been amended.
4. Claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 have been examined.

**RESPONSE TO ARGUMENTS**

5. Applicant's arguments received on have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claims 1, 23, and 45 Applicant argues that the Examiner has failed to specifically point out how the references disclose or teach each element and limitation recited in the claims. The rejections of claims 1, 23, and 45 have been updated. It should be noted that the Examiner is not required to map each limitation to a cited passage within the prior art of reference, as is suggested by the Applicant, nor is it the Examiner's responsibility to translate the technology, techniques, and/or methods of the prior art of record, since it is the assumption of the Examiner that the Applicant and the Applicant's representatives are those of at least ordinary skill in the art. Since the Examiner assumes that the Patents used in making the

rejections with regard to and in light of the instant claims have complied with the enablement standards set for the by the United States Patent and Trademark Office, the Examiner correctly deduces that one of common skill would be able to read, understand, and manufacture the innovation as disclosed by the inventors. Subsequently, since the Applicants and their representatives are considered to be at least fundamentally schooled in the arts of the instant invention, it is also correct for the Examiner to infer that the same are capable of comprehending and appreciating the prior art as disclosed by the inventors and accredited by the USPTO. Ergo, the passages cited by the Examiner are a courtesy meant not only to lay a foundation of rejection of the claim limitations, but also to introduce the prior art of record as a benchmark of knowledge currently employed by artisans of the past and present, and also for establishing a pathway for continued prosecution. It is incumbent upon the Applicant and the Applicant's representative, then, to evaluate the prior art of record, point out misconceptions or other inaccuracies made by the Examiner, assert limitations that have not been properly addressed or that are novel, and, if deemed necessary, amend the claims to overcome the prior art of record, each and all in pursuit of an allowance.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of the references discloses long standing and common techniques for distribution of digital works over a computer network, stretching back nearly a decade.

Applicant's arguments regarding the Examiner's use of inherency have been noted, but are moot. The inherency rejections have been withdrawn in lieu of the current rejections.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 5,634,012), in view of Ginter et al. (US 5,892,900), and further in view of Biddle et al. (US 200210107809 A1).

**Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 23, 45:**

Stefik discloses a fee accounting mechanism for reporting fees associated with the distribution and use of digital works (Stefik: Abstract; Figs 1-2, associated text; C4, L12-19, as well as column 45, "Distribution Scenarios"). Ginter discloses a Virtual Distribution Environment (VDE) wherein digital property may be distributed via a tightly controlled "chain of distribution and control", from creator to distributor, retailer, license administrator, to user; this VDE system may also incorporate certification authorities, banks and financial institutions, as well as multiple

content repositories, all securely communicating with each other over a distributed network. Each communication to and from the nodes of the network comprises a VDE "object", in which content, permissions governing the use of said content, budgets, node identification, transaction identification, and other pertinent information may be incorporated in order to tightly control the distribution and use of the content (Ginter: Abstract; Background and Summary of the Invention; Figs 1-5, 78-79, associated text). Biddle discloses a system for licensing management of digital property wherein a creator/vendor (Applicant's "licensor") may work with a distributor (Applicant's "retailer") to distribute software to users. In order to use this software, the user is required to obtain a license, either directly from the licensor or via the distributor (Biddle: Abstract; Summary of the Invention; Page 3, Par. 17, Figs 1-2, associated text). The combination of Stefik, Ginter, and Biddle therefore discloses the following limitations:

- *receiving, by the retailer from the customer, payment for the license, the payment to be shared with the licensor in a pre-determined manner;*
- *obtaining, by the retailer from the customer, customer-based information (Stefik: C13, L11-23, L51-58: "repository identifier");*
- *composing, by the retailer, an actual license request including the obtained customer-based information, and including retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor, and forwarding, by the retailer to the licensor, the actual license request.*

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the teachings of Stefik, Ginter, and Biddle to arrive at a system and method comprising all the limitations of claims 1, 23, and 45. Such a system would provide a secure, trusted method for a retailer to distribute protected digital property to users and control the revenue owed to the retailer, while accurately accounting for the revenue it in turns owes to the creator/licensor of the product.

With regard to the limitations of:

- *the customer has a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license, wherein obtaining the customer-based information comprises:*
- *delivering, by the retailer to the customer, a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer,*
- *delivering, by the retailer to the customer, a controller that can control the DRM system of the customer, wherein such controller directs such DRM system to send a dummy license request for a license for the dummy package, the dummy license request being directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package; and*
- *receiving, by the retailer at the interposing site from the customer, the dummy license request including customer-based information, and wherein composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information;*

Stefik, in at least column 48, lines 29-67, discloses demo versions and upgrading digital works, which reads on Applicant's "Dummy License" used to facilitate the acquisition of a proper license after viewing or playing a demo version of the digitized work. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Stefik's technique of providing a demo version to entice a user to purchase a license because this allows consumer to preview material before purchasing the full or expanded rights to that digitized work.

**Claims 2, 24, 46:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45. The combination of Stefik/Ginter/Biddle does not specifically disclose *the customer has a digital rights*

*management (DRM) system to ensure that the content is rendered in accordance with the license, the method comprising obtaining the customer based information by a request directed to the DRM system of the customer.* However, both Stefik and Ginter further describe secure environments within their user devices (Stefik: Figs 4b, 12; associated text; Ginter: Fig 6, associated text). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have ensured that a system configured to encrypt/decrypt and render the protected digital property distributed should be made tamper proof, so that unauthorized access and use can be prevented.

**Claims 3, 25, 47:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 2, 24, 46. The combination of Stefik/Ginter/Biddle does not specifically disclose *obtaining the customer-based information by delivering a controller to the customer that directs the DRM system of the customer to send the customer-based information to the retailer.* However, Biddle further discloses downloading a Java applet to manage the interactions between the user system, the licensor, and the retailer (Biddle: Page 11, Par. 93). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated the capability for causing the user DRM system to provide the user information whenever a request for license is made. This would uniquely identify the user to the retailer and provide reliable authentication for the license request.

**Claims 5, 27, 49:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *the dummy license request contains a content ID identifying the dummy package, the method comprising modifying the dummy license request to change the content ID to a content ID identifying an actual package having actual content corresponding to the to-be-issued license.* However, both Stefik and Ginter

further disclose that their systems allow a retailer/distributor to securely modify digital transmissions in many different ways, so that permissions/requests/authorizations may be changed, as long as the authoring system is allowed to do so (see all above Stefik and Ginter citations). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to provide the further limitations of these claims, so that (1) the retailer's server knows what content the user is trying to license and (2) the server forwards a correspondingly accurate license request to the licensor. Such a method would allow keeping "actual" license identifiers even more secure, thus preventing unauthorized requests from being sent to the licensors directly from the users.

**Claims 6, 28, 50:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *receiving the dummy license request including customer information comprising a customer secret*. However, all three references cited disclose the use of private/public key encryption and user passwords (Applicant's "customer secret" for authentication of user requests (see all above citations). Therefore, it would have been obvious for one ordinarily skilled in the art to use one of the "secrets" taught by the references in further securing the authenticity of the request for licensing coming from a potential customer.

**Claims 7, 29, 51:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *delivering a controller that directs the DRM system to send a license request for the dummy package by commanding that the dummy package be played*. However, Ginter further discloses that his VDE object may include programming code in the permissions records that will be executed ("played") as part of the authorization/authentication process (see Ginter references cited above). Therefore, it would

have been obvious to one ordinarily skilled in the art at the time the invention was made to incorporate such an application in a transmission from a retailer to a user, thus causing an automatic response from the user system for a request for license to be created and returned. This would negate the need for any intervention from the user, making the system more secure and attractive.

**Claims 8, 30, 52:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *delivering the controller comprises downloading such controller to the customer*. However, Biddle further discloses that executable applets may be downloaded to the user's system to effect actions required for the continued transaction between retailer, user, and licensor (see claim 3 above). Using the same obviousness and motivation analysis as claims 3 and 7 above, the combined references therefore meet the further limitations of these claims.

**Claims 9, 31, 53:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 8, 30, 52. The combination of Stefik/Ginter/Biddle does not specifically disclose *delivering the controller comprises downloading such controller to the customer as part of a page such as an HTML web page*. However, Biddle further discloses that the applet may be delivered via a Web page (see Biddle citation used in claim 3 above) . It would have been obvious to one ordinarily skilled in the art at the time the invention was made to include this feature, in order to take advantage of the continued growth and popularity of the Internet for the delivery of digital content.

**Claims 10, 32, 54:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *delivering, to the customer, a*

*dummy package having no substantial content therein.* However, Biddle further discloses that "demonstration" licenses may be used to provide an incentive for users to try out or sample a digital content (Biddle: Page 7, Par 67). Therefore it would have been obvious to one ordinarily skilled in the art to include this feature in order to create a pleasant, attractive incentive for a user who's on the verge of ordering a license for a new product, without giving away too much of the product itself.

**Claims 11, 33, 55:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 4, 26, 48. The combination of Stefik/Ginter/Biddle does not specifically disclose *delivering, to the customer, a dummy package having no corresponding license, wherein the sending of the dummy license request results at least in part from the lack of a corresponding license.* However, Biddle further discloses the use of demo licenses (see above claims). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to use such a dummy license request in case a corresponding license is not available yet, i.e. the product has not been finalized. The customer may still send in a request for a full license, which will be delivered at a later date; this way, the customer may pre-order or reserve the product now, thus improving the chance of getting the sale for the product.

**Claims 12, 34, 56:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45. The combination of Stefik/Ginter/Biddle does not specifically disclose *forwarding the actual license request to a license server.* However, all three references further disclose that licenses may be obtained from servers belonging to licensors (see all above citations).

**Claims 13, 35, 57:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45. The combination of Stefik/Ginter/Biddle does not specifically disclose *composing the actual license request to include retailer-based information comprising a retailer ID identifying the retailer.* However, all three references further disclose that communications from each participant in their systems require the participant's unique ID (see all above citations). Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to ensure that a retailer's ID would be included in any request for product licensing, for proper authorization, authentication, and accounting.

**Claims 14, 36,58:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45. The combination of Stefik/Ginter/Biddle does not specifically disclose *composing the actual license request to include retailer-based information comprising a secret that proves to the licensor that the retailer actually authorized issuance of a license by such licensor.* However, all three references further disclose using public/private key encryption systems to authenticate each participant in their systems. Biddle further discloses that a distributor/retailer may be the one authorizing a creator/vendor to license products to be distributed by the distributor/retailer (see all above citations). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have incorporated in the license request a retailer's "secret", so that only with an authorization from that retailer would a licensor deliver the requested license.

**Claims 15, 37, 59:**

Stefik in view of Ginter and Biddle disclose all the limitations of claims 1, 23, 45. The combination of Stefik/Ginter/Biddle does not specifically disclose *comprising receiving, from the customer, a selection of the content.* However, Biddle further discloses that the user may select different features or content (Biddle: Figs 22, 25, associated text; Page 7-8, Par. 71). Therefore,

it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included this feature, to make the service more attractive to the user by providing choices of content to license.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is (703) 306-9131. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is (703) 305-3900.

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JAR  
28 July 2004

